

## REMARKS

Claims 1-18 are pending.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-10 and 12-18 are rejected under 35 U.S. 103 (a) as being unpatentable over Laridon et al. (US 4282309).

### **Response to Amendment**

Examiner states that the amendment filed on December 9, 2002 does not comply with the requirements of 37 CFR 1.121 because it fails to contain a clean copy of the claims. Appropriate correction is required. Applicant is enclosing a clean copy of the amended claims with status indicators according to the Revised Amendment Practice 37 CFR 1.121 effective July 30, 2003.

### **35 U.S.C. 112, First paragraph**

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph. The examiner failed to find sufficient support for the amendment to claim 1 wherein a "C<sub>3</sub>-C<sub>9</sub> heteroaryl is substituted by phenoxy carbonyl, OR<sub>3</sub>, SR<sub>4</sub>, SOR<sub>4</sub> or NR<sub>5</sub>R<sub>6</sub>" as set forth in lines 25-26 of claim 1.

This is a self-evident typographical error in claim 1 corrected by the Applicant in the amendment of December 9<sup>th</sup>. The C<sub>6</sub>-C<sub>20</sub> aryl groups are already defined in claim 1 according to lines following Ar<sub>1</sub> 1-9. It is clear that the portion of the definition of Ar<sub>1</sub> after "provided that R<sub>1</sub> is acetyl," is directed to the definition of the heteroaryl groups. The Applicants' specification also contains the same error on page 2, lines 11-12. However on page 9, lines 13-16 and claim 4 heteroaryl definitions following "provided that R<sub>1</sub> is acetyl" show quite clearly the intended group should be "C<sub>3</sub>-C<sub>9</sub> heteroaryl" rather than "C<sub>6</sub>-C<sub>20</sub> aryl or C<sub>6</sub>-C<sub>20</sub> aryloyl". Therefore the Applicants have deleted the error and corrected as shown in the clean copy of the claims.

Reconsideration and withdrawal of the rejection of claims under 35 U.S.C. §112, first paragraph is therefore solicited. No new matter has been added.

### **35 U.S.C. 103 (a)**

Claims 1-10 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laridon et al.

Examiner maintains that Laridon clearly teaches that R<sub>5</sub> is a hydrogen atom and R<sub>4</sub> is a alkaryl group. Examiner further states that although not exemplified, one of ordinary skill in the art can readily envision the use of hydrogen and alkaryl as suitable substituents making the instant invention obvious over the cited prior art.

The Applicants asserts that they have surprisingly discovered that the claimed aldoxime compounds have enhanced results not made obvious by the Laridon cited prior art. However, the Examiner has considered the declaration submitted on December 12, 2002 but does not consider it convincing for a number of reasons: The Applicant has used preferred substituents which may give enhanced results; the Examiner is uncertain why the Applicants have selected the two substituents used in the declaration and not something more closely related to the taught compound such as an aryl substituted with a C<sub>2</sub>-C<sub>12</sub> alkoxycarbonyl group; and finally the declaration fails to compare the closest prior art.

The Applicants respectfully disagree with the Examiner's objections for the following reasons:

#### Choice of Compound A of Cited Prior Art

Applicants are obliged to compare compounds from the prior art, which are "actually taught" or exemplified. See *ex parte Westphal* 223 USPQ 630. Laridon explicitly gives a preference for compounds having at least one acyl group for R<sub>4</sub> and/or R<sub>5</sub> (see Col. 3, line 2-3) and also specifically discloses only compounds of this kind, (A)-(E) in col. 3. All of Laridon's specifically disclosed ketoxime compounds having either a "CH<sub>3</sub>" or a "phenyl" instead of the "H" of the Applicant's invention. The short alkyl chain of CH<sub>3</sub> is closer to the "H" than a phenyl. Thus, for comparison the Applicants chose the closest compound, a compound with a CH<sub>3</sub>. Further, all of Laridon's specifically disclosed, preferred compounds bear unsubstituted benzoyl groups in contrast to the Applicants presently claimed substituted aryl groups. Note that the Applicants do not claim aroyl groups for Ar<sub>1</sub>. Thus, using the preferred unsubstituted benzoyl compound from Laridon is entirely correct. To summarize, Applicants

selected the Laridon compound from the *preferred genus*, group closest to "H" and compared compounds with identical oxime substituents. This logic gives compound A of the Laridon examples.

#### Choice of Compounds B1 and B2 from Instant Application

The Applicants selected from their exemplified compounds identical substituents in the oxime part. The Examiner has stated "the Applicant has used preferred substituents which may give enhanced results". However, the Applicants selected *substituted aryl because the unsubstituted compounds are not encompassed by the instant claims*. The aryl substitution is a distinct feature of the Applicants invention. Further, Applicants not only compared the one closest compound according to Laridon's structures (B1) but also showed an improvement with compound (B2), identical in the oxime part of the molecule, but structurally quite different in the aryl of B1. This is a clear indication, that the compounds of the present invention exhibit good performance over the broad scope. Thus the rational for the choices of compounds B1 and B2 for comparison purposes is entirely correct given the compounds exemplified by Laridon et al. and those claimed and exemplified by the instant invention.

Moreover, the Applicants chose a system for the photopolymerization comparison as close as possible to the Laridon example. The basic components of Laridon's system are an acrylic copolymer, a pentaerythritol acrylate and as a solvent acetone, typical main components of a UV-curable composition (see example 1 of Laridon). Applicants tests in the declaration and instant invention used a corresponding acrylated copolymer, a pentaerythritol acrylate and the solvent acetone (see example 31 of the instant invention and "Experimental Procedure" for declaration). Therefore, the photocurable formulation for the sensitivity tests were also entirely correct and directly comparable.

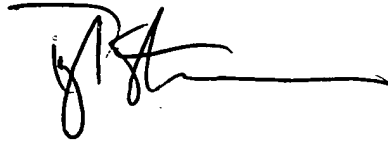
A reduction in exposure time by more than 50% is a surprising and considerable improvement in quality of the manufactured product, an unexpected result for the Applicants' aldoximes in light of the cited prior art. The declaration selection of compounds for comparison and results clearly show that the photosensitivity of compounds B1 and B2 are superior to that of compound A. Therefore, the Applicants request that the 103(a) rejection over Laridon et al. be withdrawn.

Reconsideration and withdrawal of the rejection of claims 1-18 is respectfully solicited in light of the declaration and remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tyler Stevenson', with a long horizontal flourish extending to the right.

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Enclosure: Petition for two month extension